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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,447	03/02/2004	Janzen Lo	BBM-147US	3444
23122	7590	02/13/2009		
RATNERPRESTIA			EXAMINER	
P.O. BOX 980			HOFFMAN, MARY C	
VALLEY FORGE, PA 19482				
			ART UNIT	PAPER NUMBER
			3733	
			MAIL DATE	DELIVERY MODE
			02/13/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/791,447	<b>Applicant(s)</b> LO ET AL.	
	<b>Examiner</b> MARY HOFFMAN	<b>Art Unit</b> 3733	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 October 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3-21 is/are pending in the application.
- 4a) Of the above claim(s) 6-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-5, 20 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

In view of the Appeal Brief filed on 09/15/2008, PROSECUTION IS HEREBY REOPENED. Rejections are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4-5 and 20-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Zucherman et al. (US 2008/0027552).

Zucherman et al. disclose an implant insertion device (FIGS. 184-185, 194, see next figures below) comprising: an insertion rod (5010) having a longitudinal axis; and an implant gripper (5030) attached to the insertion rod, the implant gripper including: a v-shaped gripping surface (see FIG. 194) intersecting the longitudinal axis of the insertion rod; a first pin (FIG. 185, 5560) extending from and fixed relative to the v-shaped gripping surface; and a second pin (FIG. 185, 5555) extending through and movable relative to the v-shaped gripping surface between a first position wherein the second pin extends from the v-shaped gripping surface a distance  $x$  and a second position wherein the second pin extends a distance less than  $x$  from the v-shaped gripping surface, wherein the first pin and the second pin are offset on the v-shaped gripping surface and extend in a non-parallel manner. The first pin and the second pin are smooth. The implant gripper is removable from the insertion rod (see FIG. 185). See figures next:

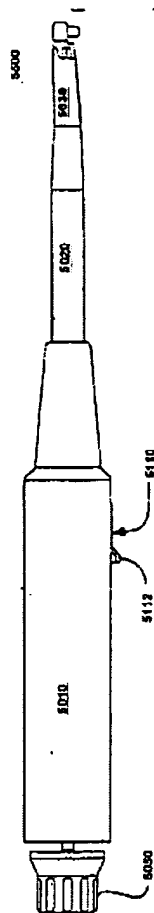


FIG. - 184

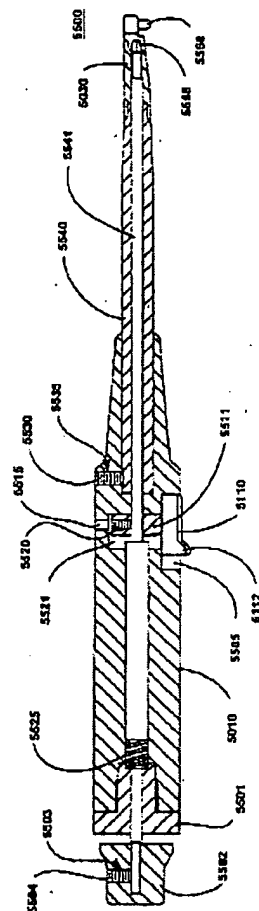


FIG. - 185

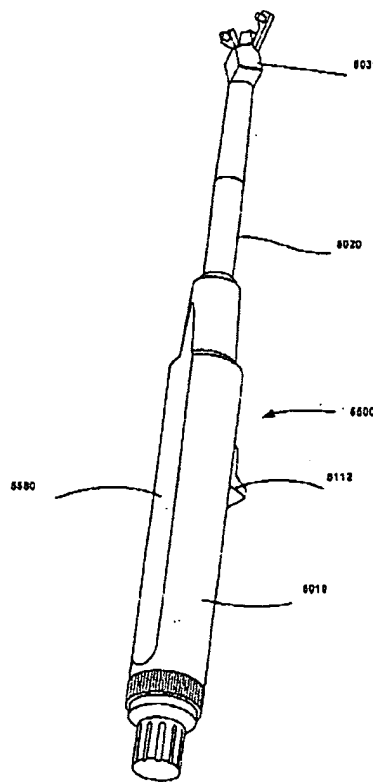


FIG. - 194

Zucherman: FIGS 184-185 and 194

According to the same interpretation, Zucherman et al. further disclose an implant insertion device (FIGS. 194, also see FIGS. 184-185) comprising: an insertion rod having a longitudinal axis; and an implant gripper extending from the insertion rod, the implant gripper including: an implant gripping surface intersecting the longitudinal axis of the insertion rod; a first pin extending from and fixed relative to the implant gripping surface; and a second pin extending through and movable relative to the implant gripping surface, the second pin being substantially aligned with the longitudinal axis of the insertion rod and non-parallel to the first pin.

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Similarly, Zucherman et al. further disclose an implant insertion device (FIG. 194, also see FIGS 184-185) comprising: a handle (see bottom of FIG. 194, also see FIG. 195, 5010) having a gripping surface; an insertion rod extending from the handle, the insertion rod defining a longitudinal axis; an implant gripper extending from the insertion rod, the implant gripper including: an implant gripping surface intersecting the longitudinal axis of the insertion rod; a first pin extending from and fixed relative to the implant gripping surface; and a second pin extending through and movable relative to the implant gripping surface, the second pin being substantially aligned with the longitudinal axis of the insertion rod and non-parallel to the first pin; and an actuator positioned proximal to the handle for moving the second pin relative to the v-shaped gripping surface.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

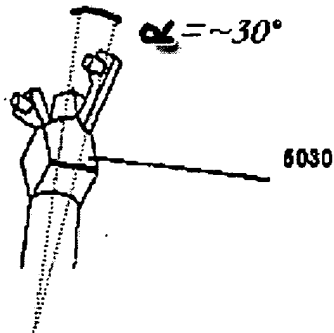
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zucherman et al. (US 2008/0027552).

Zucherman et al. discloses the claimed invention except for explicitly stating that the first pin and the second pin are offset on the gripping surface by an angle of

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approximately 30 degrees (from the below figure, however, it appears that the first and second pin might be offset at an angle of approximately 30 degrees).



*Zucherman: Partial View of FIG. 194*

It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Zucherman with the first pin and the second pin are offset on the gripping surface by an angle of approximately 30 degrees since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARY HOFFMAN whose telephone number is

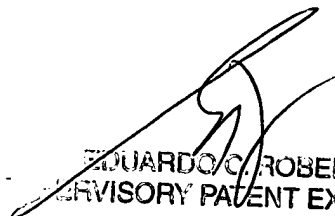
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(571)272-5566. The examiner can normally be reached on Monday-Thursday 10:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mary C. Hoffman/  
Examiner, Art Unit 3733

  
EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER